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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,246	12/18/1999	GEORGE BUSH	3133-26	8658

7590 02/23/2004
PITNEY HARDIN KIPP & SZUCH LLP
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New York, NY 10017

EXAMINER

GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/465,246

Applicant(s)

BUSH

Examiner

Grigory Gurshman

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because some of the figures are drawn by hand. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. The terms "substantially unique and substantially undecryptable" in claims 1, 7, 10 and 15 are the relative terms, which render the claims indefinite. The terms "substantially unique and substantially undecryptable" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

4. Claim 16 recites the limitation "the method of claim 16". There is insufficient antecedent basis for this limitation in the claim.

5. Claim 17 recites the limitation "the method of claim 17". There is insufficient antecedent basis for this limitation in the claim.

6. Claim 18 recites the limitation "the method of claim 18". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romney (U.S. Patent No. 5,872,848) in view of Brown (U.S. Patent No. 6,671,805 B1).

9. Referring to the instant claims, Romney discloses method and apparatus for authenticating an electronic document (see abstract and Fig.1). Romney shows verification of sending of the electronic document by the sender (originating party 100 in Fig.1) and verification of the receipt of the electronic document by a recipient (receiving party 160 in Fig.1) in association with a third party (authenticator 130 in Fig. 1). Romney teaches that a message digest is a value that is generated when an electronic document is passed through a one way encryption process ("digesting process") such as a hashing routine. An ideal digesting process is one for which the probability that two different electronic documents will generate the same message digest is near zero. In this form of digital signature, both the sender and the recipient need to know which digesting process is being used. The sender generates the electronic document, and generates a message digest by passing the electronic document through the digesting process. The sender encrypts the resulting message digest with the sender's private key. The result, the encrypted message digest, then becomes the digital signature of

the electronic document. The digital signature may be appended to the electronic document or kept as a separate entity (see column 2, line 63 through column 3, lines 1-10).

10. Referring to the independent claims 1, 7, 10 and 15, the limitation "sender generating a substantially unique and substantially undecryptable first digital string based upon the electronic document" is met by an encrypted message digest (see column 3, lines 3-5).

The limitation "... communicating the first digital string to ... one third party" is met by the sender, generating the electronic document, and generating a message digest by passing the electronic document through the digesting process (see column 3, lines 3-6). The sender (originating party in Fig. 1) sends the encrypted message digest to the third party (authenticator in Fig 1.). The limitation " ... third party , in response to a request from the recipient, communicating to the recipient first digital string and a decryption key ..." is met by authenticator (130 in Fig. 1) sending the document authenticator certification (150 in Fig.1). Referring to the limitation "... recipient further generating ... undecryptable second digital string based upon the ... electronic document and comparing the first digital string to the second digital string" is met by generating second message digest Y for the electronic document and comparing message digest Y to the first message digest X (see column 5, lines 10-20).

11. Romney, however does not explicitly teach encrypting portions of an electronic document with different encryption algorithms. Referring to the instant claims, Brown discloses a method for document-driven processing of digitally-signed electronic

documents (see abstract and Fig.1). Brown teaches the use message digest and encryption (see unit 108 in Fig.2). Brown teaches a computer-implemented method for digitally signing an electronic document by a plurality of signers, each signer having a signing role and a unique private key for applying a digital signature, each signing role corresponding to a to-be-signed portion of the document, at least two signing roles corresponding to different to-be-signed portions (see column 33, lines 55-62).

Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to verify the electronic document by comparing encrypted message digests at sender and the receiver using the third party of Romney while having portions of the document encrypted using different key (i.e. algorithms) as taught in Brown. One of ordinary skill in the art would have been motivated to verify the electronic document by comparing encrypted message digests at sender and the receiver using the third party while having portions of the document encrypted using different algorithms as taught in Brown for implementing different roles of signers (see Brown column 33, lines 58-60 and Fig 2 unit 104).

12. Referring to the independent claims 10 - 15, Romney teaches recording all of the requests and transactions onto the removable media and onto mass storage (see Fig. 10 unit 1070 and Fig.11).

13. Referring to claim 15, "document identification number" is met by the tag (see Brown Fig. 3, unit 308).

14. Referring to claim 2, it is well known in the art to communicate the third party the numbers or IP addresses identifying the sender and the recipient. One of ordinary skill

in the art would have been motivated to communicate the third party the numbers identifying the sender and the recipient for proper verification and routing of the encrypted electronic document.

15. Referring to claim 4, Romney teaches the use of an asymmetric encryption algorithm (see abstract).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 5.748.738 to Bisbee et al

U.S. Patent No. 5.915.024 to Kitaori et al

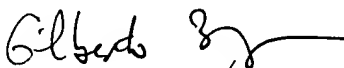
U.S. Patent No. 6.157.721 to Shear et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (703) 306-2900. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.




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